



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,721	04/10/2001	Glenn R. Smith	SVL920010005US1	8452
46158	7590	03/30/2009		
Tucker Ellis & West LLP 1150 Huntington Bldg, 925 Euclid Ave Cleveland, OH 44115-1414			EXAMINER VAUGHN, GREGORY J	
			ART UNIT	PAPER NUMBER
			2178	
			MAIL DATE	DELIVERY MODE
			03/30/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GLENN R. SMITH and LETITIA K. LEE

Appeal 2008-3091
Application 09/829,721
Technology Center 2100

Decided:¹ March 30, 2009

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and
JAY P. LUCAS, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

The Patent Examiner rejected claims 2, 3, 6-8, 11-13, 15, 16, 21, and 22. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

INVENTION

The invention at issue on appeal is a text entry dialog box that "retains the appearance of a conventional text entry line while providing a way to recall previously entered text." (Spec. 6, ll. 17-18.)

ILLUSTRATIVE CLAIM

21. A graphical user interface text input dialog including:

- a free-form text entry portion displayed on an associated display device for receiving a free-form text entry from an associated user;

- a memory storing free-form text entries previously entered by the associated user into the free-form text entry portion;

- a drop-down list selection button displayed in conjunction with the free-form text entry portion only when the memory contains at least one previously entered free-form text entry; and

- a drop-down selection list portion displayed in conjunction with the free-form text entry portion responsive to activation by the associated user of the drop-down list selection button, the drop-down selection list portion listing the previously entered free-form text entries stored in the memory for selection by the associated user.

PRIOR ART AND REJECTION

Microsoft Corporation, *Microsoft Word 2000* (1999)
(screen shots of the software application running on the
Examiner's computer workstation) (hereinafter "MS Word").

William B. Hayes, et al., *Using PowerBuilder 6: Special
Edition*, 181, 331 (QUE Corporation, 1997) (hereinafter
"PowerBuilder").

Claims 2, 3, 6-8, 11-13, 15, 16, 21, and 22 stand rejected under 35
U.S.C. § 103(a) as unpatentable over MS Word and PowerBuilder.

ISSUE

"Rather than reiterate the positions of parties *in toto*, we focus on the
issue therebetween." *Ex parte Filatov*, No. 2006-1160, 2007 WL 1317144,
at *2 (BPAI 2007). The Examiner admits that "MS Word fails to disclose
the selective display of a selection button (i.e. the show-list-button)
associated with the dialog box, where the selection button is visible when at
least one text entry is stored in memory. In the examples described . . . the
show-list-button is always displayed." (Answer 6.) He finds, however, that
"PowerBuilder 6 discloses controls built into the drop down box selection
button (the arrow) on page 3." (*Id.*) He also finds that the latter reference
recites:

*"Disable Scroll: If Disabled Scroll is checked, the scroll bar will
always be visible but will be disabled when you can access all the
items without scrolling. If this property is not checked, the scroll bar
will be displayed only if necessary, based on the number of items and
the height of the listbox."*

(*Id.* at 6-7.) The Appellants argue that "[n]one of MS Word, PowerBuilder 6, or their combination, disclose or fairly suggest a drop-down list selection button displayed in conjunction with the free-form text entry portion only when the memory contains at least one previously entered free-form text entry." (App. Br. 20.) Therefore, the issue before us is whether the Appellants have shown error in the Examiner's finding that the combination of MS Words and PowerBuilder would have suggested displaying a drop-down list selection button along with a free-form text entry portion only when a memory contains at least one previously entered free-form text entry.

LAW

"The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art." *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)).

FINDINGS OF FACT ("FFs")

1. MS Word discloses a "Find and Replace box available from the Edit menu" (Answer 5.) More specifically, "Figure 5 discloses a text entry space in [the Find and Replace] box displayed on a screen of the display device for free form entry of text by the user." (*Id.*)

2. "In Figure 8, MS Word discloses displaying a list of previously entered text items that had been stored in memory. To access this list of

previously entered text items, the user would select the show-list-button (displayed as a square box with a downward pointing arrow)." (*Id.* at 6.) The Figure also shows a scroll bar for navigating the list of previously entered text items.

3. "PowerBuilder recites: 'Always Show Arrow: The Always Show Arrow checkbox always shows the arrow that opens the list box. If Always Show Arrow is unchecked, the arrow is shown only when the column has focus.'" (*Id.* (italics removed).)

4. The Appellants explain that a "user selects, or focuses upon, a particular input dialog box either by selecting it with the pointing device or through a keyboard combination, such as by pressing TAB." (Spec. 2, ll. 13-14.)

5. "PowerBuilder 6 recites: 'Disable Scroll: If Disabled Scroll is checked, the scroll bar will always be visible but will be disabled when you can access all the items without scrolling. If this property is not checked, the scroll bar will be displayed only if necessary, based on the number of items and the height of the listbox.'" (Answer 6-7 (italics removed).)

ANALYSIS

We agree with the Examiner that MS Word's show-list-button constitutes a drop-down list selection button (FF 2) that "is always displayed" (Answer 6). We also agree with him that PowerBuilder features

an Always Show Arrow checkbox that, when unchecked, selectively controls display of an arrow. (FF 3.) As argued by the Appellants (Reply Br. 11), however, the selective display is not based on the contents of a memory, as claimed, but on whether a column has focus (FF 3), i.e., has been selected (FF 4).

We also agree with the Examiner that PowerBuilder features a Disable Scroll checkbox. (FF 5.) When unchecked, a scroll bar will be displayed "only if necessary, based on the number of items and the height of the listbox." (*Id.*) We find that if the teaching of the Disable Scroll were combined with the teaching of MS Word's Find and Replace box, the resulting combination would have controlled the displaying of the box's scroll bar rather than its show-list-button.

CONCLUSION

Based on the aforementioned facts and analysis, we conclude that the Appellants have shown error in the Examiner's finding that the combination of MS Word and PowerBuilder would have suggested displaying a drop-down list selection button along with a free-form text entry portion only when a memory contains at least one previously entered free-form text entry.

ORDER

We reverse the rejection of claims 2, 3, 6-8, 11-13, 15, 16, 21, and 22.

REVERSED

Appeal 2008-3091
Application 09/829,721

msc

TUCKER ELLIS & WEST LLP
1150 HUNTINGTON BLDG, 925 EUCLID AVE
CLEVELAND, OH 44115-1414